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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/165,522	10/02/98	DAVIS	R 10363/005001

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HM22/0316

EXAMINER

MARTIN, J

ART UNIT

PAPER NUMBER

1632

DATE MAILED:

03/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Five

Office Action Summary

Application No.
09/165,522

Applicant(s)
Davis et al.

Examiner
Jill D. Martin

Group Art Unit
1632



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-17 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-17 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to methods for screening compounds which modulate JNK3 expression, activity, or binding, classified in class 435, subclass 4, 6, and 7.1, for example.
- II. Claims 7-8, and 12-17, drawn to methods of making mouse totipotent cells comprising an inactivated JNK3 gene, methods for making a mouse homozygous for an inactivated JNK3 gene, transgenic non-human mammals having an inactivated JNK3 gene, a cell line isolated from the mammal, and a DNA construct for inactivating the JNK3 gene in a mouse, classified in class 800, subclass 14, 21, 22, and 25, and class 435, subclass 463, 320.1, and 325, for example.
- III. Claims 9-11, drawn to a method of treating a patient for disorders involving excitotoxicity comprising administering an antisense nucleic acid molecule, classified in class 514, subclass 44, for example.
- IV. Claims 9 and 11, drawn to a method of treating a patient for excitotoxicity comprising administering an undisclosed compound, unclassifiable.

Note that claims 9 and 11 are generic to Inventions III and IV. However, Invention IV cannot be held as searchable as it is directed to an undisclosed compound.

The inventions are distinct, each from the other because of the following reasons:

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The methods of each of Inventions I-III are materially different and plurally independent from each other because each is practiced with materially different process steps, technical considerations, and reagents. Methods of screening for compounds having JNK3 activity requires no therapeutic considerations as does the method of Invention III. Furthermore, the production of transgenic animals of Invention II involves materially different technical considerations and requires search and consideration of methods for the production of transgenic animals. Such analysis is not required for the investigation of Inventions I, or III. Thus, the differences of Inventions I-III are further underscored by their divergent classification and independent search status.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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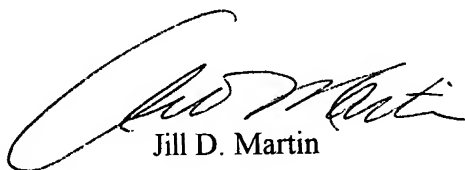
amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill Martin whose telephone number is (703)305-2147.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine C. Chambers, can be reached at (703)308-2035.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0196.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.

A handwritten signature in cursive script, appearing to read "Jill D. Martin", is written over the printed name.

Jill D. Martin

Patent Examiner